

REMARKS

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 pending. The application has been carefully reviewed in light of the Office Action, and claims 1, 6, 9 and 10 have been amended to address the issues raised by the Examiner. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below, and favorable action is requested.

Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claims 1-15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response thereto, Applicant has amended claims 1, 6, 9 and 10. It is believed that the amendments now place these claims in condition for allowance.

Claim Rejections – 35 U.S.C. 102

The Examiner has rejected claims 1,2,10-12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 750,620 to Dohse. Applicants traverse this rejection for the following reasons.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In light of the amendments that have been made to independent claims 1 and 10, the Dohse patent does not describe each and every element in claims 1,2,10-12. Amended claim 1 recites, in part, “the entire surface of the detachable chip section and the surface of the area surrounding the detachable chip section are coated with a layer of the first colored coating composition.” In contrast, the Dohse patent shows that the separable color-display sections are not colored in their entirety. In fact, it is apparent that the colored portion of the separable color-display section is

framed by a non-colored (or white) area. Moreover, the color-display sections adjacent any separable color-display section also have a non-colored frame surrounding the colored portion. Therefore, if a window is created by detaching any color-display section, that window is framed by a non-colored border. Applicants amended claim 1 indicates that even if the chip section is detached (as recited in dependent claim 2), the area surrounding the detached portion of the paint color card is colored with the first colored coating composition. Therefore, claim 1 is not anticipated by the Dohse patent. Accordingly, because claim 2 is dependent from claim 1, claim 2 is not anticipated by the Dohse patent.

Amended claim 10 claims “the chip section and area surrounding the chip section are coated with a layer of the colored coating composition.” The Dohse patent does not disclose that the entire surface of the separable color-display section is coated or colored, nor is the area surrounding the color-display section coated or colored. Therefore, independent claim 10 is not anticipated by the Dohse patent, and accordingly, dependent claims 11 and 12 are not anticipated by the Dohse patent.

Claim Rejections – 35 U.S.C. 103

The Examiner has rejected claims 3 and 13 under 35 U.S.C. 103(a) as being unpatentable over Dohse. Applicants traverse this rejection for the following reasons.

The Examiner asserts that the Dohse patent discloses the applicants’ basic inventive concept of making the chip sections square. Specifically, the Examiner states that the Dohse patent discloses the idea of making the chip sections rectangular and it would have been obvious to make the chip sections square.

The Dohse patent does not disclose Applicants’ basic inventive concept except for making the chip sections square. The Examiner has stated that “applicant fails to provide any advantage to making the sections square” and the rectangular section taught by Dohse would work equally well. Applicants submit that the Dohse patent, and not the Applicants’ application, must suggest the desirability and thus the obviousness of making the combination that the Examiner has set forth (MPEP Section 2141.) The Dohse patent, however, only suggests utilizing a rectangular shape for its separable display sections. It is the Dohse patent, and not the Applicants’, that must provide the motivation to utilize a square shape.

Moreover, in order to establish *prima facie* obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). As discussed previously, claims 1 and 10 have been amended to claim elements that are not disclosed in the Dohse patent. Therefore, it is respectfully submitted that the Dohse patent does not teach or suggest all of the limitations disclosed in claims 1 and 10, and the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1 and 10. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, claims 3 and 13 are nonobvious and patentable over the Dohse patent.

The Examiner has rejected claims 4 and 14 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Spangler (U.S. Patent No. 6,270,123). The Examiner states that Dohse discloses Applicants' basic inventive concept except for making the color card out of paper. Applicants traverse this rejection for the following reasons. The Dohse patent does not disclose Applicants' basic inventive concept except for making the color card out of paper. In fact, Dohse in view of Spangler does not disclose a paint card that includes all of the claimed elements in the subject application, particularly in light of the amendments to claims 1 and 10. Neither the Dohse patent nor the Spangler patent disclose a chip section whose area is coated with a colored coating composition (as claimed in amended claims 1 and 10). Moreover, neither the Dohse patent nor the Spangler patent disclose that the surface of the area surrounding the chip section is also coated with a colored coating composition (as claimed in claims 1 and 10). Accordingly, claims 4 and 14 are nonobvious and patentable over Dohse in view of Spangler.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Day et al (U.S. Patent No. 4,104,809). With respect to claims 5,6, and 15, the Examiner has stated that Dohse discloses the idea of placing indicia on each chip section to indicate the color of the paint chip but does not disclose placing a formula for the paint color. Moreover, the Examiner states that Day et al. shows the idea of placing indicia for indicating the color of each chip section and indicia for indicating a code/formula for each chip section. Applicants traverse this rejection for the following reasons.

Applicants respectfully assert that the Day et al. patent does not disclose placing an indicia *for indicating a formula* for the chip section. Day et al. discloses printing indicia, such as a strip number or an identifying code, on the color sample strip. However, Day et al. does not

disclose that the identifying code or other indicia correspond to the formula for producing the color that is exhibited on the sample strip. It is unascertainable what the code described in Day et al. identifies – for example, the code may identify a family of coordinating colors that may be used in combination with the selected color. However, Day et al. does not propose matching the code with a corresponding formula. Therefore, Day et al. does not disclose the idea of placing indicia for indicating a formula for each chip section. Claim 7, dependent from claim 5, is also nonobvious and patentable over Dohse in view of Day et al. because Day et al. does not disclose placing indicia *for indicating a formula* for the chip section. Accordingly, claims 5,6,7 and 16 are nonobvious and patentable over Dohse in view of Day et al.

Lastly, the Examiner rejects claims 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over Dohse in view of Edwards (U.S. Patent No. 4,992,050). The Examiner states that Dohse discloses the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Further, the Examiner states that Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side the chip section. Additionally, the Examiner states that Edwards discloses that the paint on the second side has a different finish as compared to the first side. The Examiner also states that in regard to claim 8, it would be obvious to place the same color on the front and back of the chip section. Applicants traverse this rejection for the following reasons. The Dohse patent does not disclose Applicants' basic inventive concept except for placing a color coating on the back of each chip section. In fact, Dohse teaches that reference-keys are placed on the back of the separable color-display sections, for the purposes of preventing confusion with the reference-key carried by the section upon which they are placed. Therefore, Dohse suggests that the preferred placement of the reference keys is on the back of the color-display section. Thus, Dohse in view of Edwards does not suggest or grant motivation to place different color or coating of paint on the back of the color-display section as compared to the color on the front, particularly because placing a color or coating on the back side would prevent the reference from being viewed.

Furthermore, Dohse in view of Edwards does not disclose a paint card that includes all of the claimed elements in the subject application, particularly in light of the amendment to claim 1. Neither the Dohse patent nor the Edwards patent disclose a perforated chip section whose area is coated with a colored coating composition (as claimed in amended claim 1). Moreover, neither

the Dohse patent nor the Edwards patent disclose that the surface of the area surrounding the chip section is also coated with a colored coating composition (as claimed in amended claim 1).


With respect to claim 9, the Examiner states that the colors on each side of the paint strip sections of Edwards are considered to be of the same color but would have different compositions. Applicants' claim 9 claims that the first colored coating composition is a different *color* than the second colored coating composition. Therefore, the Dohse in view of Edwards does not teach all of the claim elements present in Applicants' claim 9. Furthermore, in light of the amendment to claim 1, Dohse in view of Edwards does not disclose a paint card that includes all of the claimed elements as in the subject application.

Accordingly, claims 8 and 9 are nonobvious and patentable over Dohse in view of Edwards.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested.

Respectfully submitted,

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